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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,462

08/01/2003

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018158-004990US

3822

20350 7590 02/23/2007
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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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2 MONTHS

02/23/2007

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12202006

Application Number: 10/632,462
Filing Date: August 1, 2003
Appellant(s): Knopp, Carl

MAILED

FEB 23 2007

Group 3700

Patrick J. Zhang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 10, 2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendments after final have been filed.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 27-34 of copending Application No. 10/124,891. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent application "anticipate" the instant application claims. Accordingly, the instant application claims are not patentably distinct from the patent application claims. Here, the patent application claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

Claims 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5, 7- 9, 11-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pflibsen et al

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,966,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the artisan of ordinary skill in the art to employ the patented eye tracker with a laser surgical system.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Listing of Evidence Relied Upon*

The following is a listing of the prior art of evidence (e.g. patents, publications Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Number (Title)	Name	Date
4,848,340	Bille et al	July 18, 1989
4,901,718	Bille et al	February 20, 1990
5,090,798	Kohayakawa	February 25, 1992

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7, 9, 11, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al. ('340).

Bille et al. ('340) instructs the artisan of ordinary skill to use the system set forth therein with the system described in Bille et al. ('718).

Claims 1-7, 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al. ('340) in combination with Bille et al. ('718). Bille et al. ('340) teaches an eye tracking laser surgical device which will track the eye in X-, Y-, and Z-directions, including a processor, a detector, a laser, a display, and an imaging system. Bille et al. ('718) teaches a laser redirecting system to keep the surgical laser trained on the eye as the eye moves, including steering means for the X- and Y- directions and a focusing means. It would have been obvious to the artisan of ordinary skill to employ the laser steering device as taught by Bille et al. ('718) in the device of Bille et al. ('340), since Bille et al. ('340) specifically say to do so, and to

employ an analog processor rather than a computer, since analog processors respond more quickly than digital processors, official notice of which is hereby taken, thus producing a device such as claimed.

Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al. ('340) in combination with Bille et al. ('718) as applied to claims 1 and 11, and further in combination with Kohayakawa. Kohayakawa teaches that the laser must be stopped and the eye realigned before the surgery is resumed. It would have been obvious to the artisan of ordinary skill to employ the laser shut down device and method suggested by Kohayakawa in the combined device and method of Bille et al. ('340) and Bille et al. ('718), since this is required for the surgery to be successful in the case that the eye moves out of range, thus producing a device such as claimed.

(10) Response to Argument

Claims 1-5, 7, 9, 11, and 14 are clearly anticipated under 35 U.S.C. 102(b) over Bille et al. ('340).

Appellant argues, in essence, that Bille et al. ('340) does not read on the instant claims due to the limitation, contained in all independent claims, that the tissue structure involved is not a "natural" tissue structure. Appellant has provided no particular definition of what constitutes a "natural" tissue structure in the originally filed disclosure, thus the term must be given it's broadest reasonable interpretation (see Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321

(Fed. Cir. 2005), MPEP 2111). It is noted that the spots, which make up the grid of Bille et al ('340) are “small incisions created in the cornea 30 by the cutting laser” (see column 5, lines 37-38). Thus the uncut tissue remaining at the incision point is a “natural tissue structure” as claimed. Similarly, the uncut tissue which surrounds the incisions, and which provides the contrasting reflective property (relative to the incisions) that allows the electronics to track the intensity variation that the irregularity created by the incisions provide (note that it is the movement of the grid, which is a group of spots and the unincised tissue between them which is tracked) is also a “natural tissue structure” as claimed.

Claims 2-5, 7, 9, and 14 are argued as patentable solely based on the patentability of the claims from which they depend. However, as set forth above, the independent claims to which the final rejection was applied are not patentable, and thus their dependents cannot predicate patentability on the limitations of the independent claims. Thus these claims are unpatentable because where claims are not separately argued with any reasonable particularity, they stand or fall together with the claim with which they are grouped. In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); In re Kaslow, 707 F.2d 1366, 1376, 201 USPQ 67, 70 (CCPA 1979).

Claims 1-7, 9, 11, and 14 are obvious under 35 U.S.C. 103 over Bille et al. ('340) in combination with Bille et al. ('718).

As above, appellant argues, in essence, that Bille et al. ('340) and Bille et al. ('718) do not read on the instant claims due to the limitation, contained in all independent claims, that the tissue structure involved is not a “natural” tissue structure. The arguments set forth above apply

equally in this instance, and they are incorporated by reference. The examiner will not burden the record by repeating them here.

Claims 2-7, 9, 11, and 14 are argued as patentable solely based on the patentability of the claims from which they depend. However, as set forth above, the independent claims to which the final rejection was applied are not patentable, and thus their dependents cannot predicate patentability on the limitations of the independent claims. Thus these claims are unpatentable because where claims are not separately argued with any reasonable particularity, they stand or fall together with the claim with which they are grouped. In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); In re Kaslow, 707 F.2d 1366, 1376, 201 USPQ 67, 70 (CCPA 1979).

Claims 10 and 15 are obvious under 35 U.S.C. 103 over Bille et al. ('340) in combination with Bille et al. ('718) and Kohayakawa.

Claims 10 and 15 are argued as patentable solely based on the patentability of the claims from which they depend. However, as set forth above, the independent claims to which the final rejection was applied are not patentable, and thus their dependents cannot predicate patentability on the limitations of the independent claims. Thus these claims are unpatentable because where claims are not separately argued with any reasonable particularity, they stand or fall together with the claim with which they are grouped. In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); In re Kaslow, 707 F.2d 1366, 1376, 201 USPQ 67, 70 (CCPA 1979).

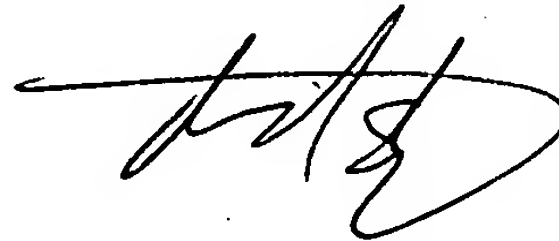
(11) Related Proceedings Appendix

NONE


(12) Conclusion


It is the examiner's firm opinion that the appealed claims are not patentable for the reasons argued above. Appellant has presented no convincing argument as to why the rejections set forth above are not obvious or proper. Therefore, it is respectfully submitted that the final rejection be affirmed

Respectfully submitted,



**DAVID M. SHAY
PRIMARY EXAMINER
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David Shay 
December 23, 2006

Conferees
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